REMARKS

This is responsive to the Office Action mailed May 5, 2008. Since the Office Action is final, it is accompanied by a request for continued examination ("RCE") together with the required fee.

Double Patenting

Claims 1 - 5, 7, 9 - 11, 17 and 22 - 26 stand rejected on the ground of nonstatutory obviousness type double patenting as being unpatentable over claims 7 - 10 of U.S. Patent No. 6,757,952. Applicant submits herewith a terminal disclaimer.

Section 112 Rejections

With regard to claim 1, clarification is required as to whether the knife is clamped between the clamping member and the wearshoe. Claim 1 has been amended to address this question; however, for the record, Applicant disagrees that the claim prior to amendment failed to meet the requirements of 35 U.S.C. §112.

This is because it is understood that the knife is a replaceable part. It follows that the apparatus must be capable of assuming two different configurations: (1) wherein the knife is not clamped (so that it can be installed into the apparatus or removed from the apparatus); and (2) wherein the knife is clamped (so that the apparatus is ready for cutting).

Therefore, whether the knife is clamped or not depends on which configuration the apparatus happens to be in, which depends on how the user interacts with the apparatus, i.e., how

the apparatus is being used. It is not a requirement under 35 U.S.C. §112 to specify in an apparatus claim how the apparatus is to be used.

On the other hand, the specification explains how the apparatus is intended to be used. As the Examiner notes, paragraph 2 on page 8 explains the following:

> The knife 36 is clamped to the base 40 by the clamp 38. Particularly, the knife is held between the upper clamping member 38a and the wearshoe 38b. The upper clamping member is bolted to the base 40 by use of a bolt 45a, and the wearshoe is bolted to the base by use of a bolt 45b (Figure 7). *However, the knife is not yet held by the clamp 38 until a clamp bolt 45c is tightened.* (emphasis added)

The Examiner also refers to Figure 6 of the disclosure, which shows two dimensions: "t," and "d," the significance of which is explained in the next paragraph (paragraph 3, page 8):

> . . . . The upper clamping member is cantilevered out from . . . [the] support [portion of the base] and without any deflection is spaced apart from the wearshoe a distance "d" that is greater than the thickness "t" of the knife. Tightening the clamp bolt 45c therefore deflects the cantilevered upper clamping member 38 elastically so as to bring it into contact with the knife.

The distance "d" is the claimed "gap," and it is explained in detail that the gap is larger than the thickness "t" of the knife unless and until the upper clamping member, which is cantilevered from the base, is elastically deflected, e.g., by tightening a clamp bolt 45c.

Section 102 Rejections

Rejections Based on Saltzmann or Buhayer

Claim 1 is rejected under 35 U.S.C. §102(b) as being anticipated by Saltzmann, U.S. Patent No. 3,559,705 or Buhayer, U.S. Patent No. 4,709,607. Applicant respectfully traverses the finality as well as the merits of the rejection.

The references cited are new references, and claim 1 had been amended merely to add a limitation (the term "cantilevered") that was present in previous versions of the claim, and to add the term "thereby bending" as an express statement of the inherent result of the structure already existing in the claim. Neither of these changes was substantive, and therefore neither change necessitated further search.

Moreover, Saltzmann and Buhayer fail to anticipate for precisely the same reasons that were explained earlier in connection with the rejections based on Little, U.S. Patent No. 3,209,801, Nicholson et al., U.S. Patent No. 3,661,192, and Hansel et al., 4,298,044. Just like these references, Saltzmann and Buhayer fail to meet the express claim requirement that the upper clamping member is "cantilevered." In response to these earlier rejections on the same grounds, Applicant has, at various times, explained the meaning of this term:

1) In a response to the Office Action mailed November 16, 2006, the response being mailed February 2, 2007, Applicant provided a photocopy of page 203 of Webster's Ninth New Collegiate Dictionary, showing the definition of the term "cantilever," which is "a projecting beam or member supported at only one end."

2) In a response to the Office Action mailed May 4, 2007, the response being mailed August 1, 2007, Applicant provided, as "Exhibit 3," a sketch of an upper clamping member and base meeting the above-referenced definition, to provide a visual example of what the term "cantilever" means.

3) In a telephone conference, the undersigned pointed out that a diving board is "cantilevered," to provide a commonly known and easily envisioned example of what the term "cantilever" means.

Since the meaning of the term "cantilevered" apparently remains contentious, Applicant here provides an Attachment, Figures 1-8 and the following discussion related thereto in a further attempt to explain the meaning of this term.

To summarize, Figures 1-4 show examples of structures that are NOT cantilevered, and Figures 5-8 show examples of structures that ARE cantilevered, the differences being apparent by comparison as follows:

Figures 1-4 (NOT cantilevered).

To provide an easily testable example, Figure 1 shows a ruler 10 being supported by the respective fingers 12a, 14a of two hands 12 and 14. Support forces are represented by "A" and "B." As can be readily appreciated, if one hand is removed, the ruler will fall. Because the ruler is not cantilevered, it needs to be supported at *two ends*.

Figure 2 shows how the example of Figure 1 maps to an assembly 20 having a base 22, an upper clamping member 24, and a knife 26 (**NOTE**: the knife 26 is illustrated--unrealistically--as a sphere for illustrative purposes only, so that it is easily distinguished from the other structures). The support forces "A" and "B" are shown and correspond identically to the support forces "A" and "B" in Figure 1. Identically to the situation depicted in Figure 1, the upper clamping member 24 will fall if the knife 26 is removed; i.e., the knife 26 provides the support force "B" which, along with the support force "A," is needed to support the upper clamping member.

Figure 3 shows the example of Figure 1 with a weight 16 (applied force "C") placed in the center of the beam 10. This causes the beam to bend between the fingers 12a and 14a and assume the shape indicated.

Figure 4 shows how the example of Figure 3 maps to the assembly 20. In all pertinent respects, Figure 4 is the same as the structures in both Saltzmann and Buhayer.

Figures 5-8 (Cantilevered)

Figure 5 shows an example of the ruler 10 of Figures 1 and 3 being supported by respective fingers 12a, 12b of one hand 12. Support forces represented by "A" and "B" "pinch" the ruler at one end, and therefore the ruler is supported at one end only–the other end being free. However, even though the ruler is supported at only one end, it will not fall. *This is a fundamental difference between a cantilevered member and a non-cantilevered member: While the non-cantilevered ruler of Figure 1 needs to be supported at two ends to keep it from falling, the cantilevered member of Figure 5 will not fall even though it is only supported at one end.*

Figure 6 shows how the example of Figure 5 maps to the assembly 20 of Figure 2.

Figure 7 shows the example of Figure 5 with the weight 16 (applied force "C") placed at the unsupported end of the ruler 10. This causes the ruler to bend as indicated. Figure 7 can be compared directly to Figure 3 to see the difference in the way the ruler bends in reaction to the weight 16 as a result of whether the ruler is cantilevered or not.

Figure 8 shows how the example of Figure 7 maps to the assembly 20. In all pertinent respects, Figure 8 is the same as what is disclosed in the present application in Figure 6.

Conclusion

Figure 6 and Figure 8 represent what is claimed, and Figures 2 and represent Saltzmann and Buhayer. Note that in both Figure 6 and Figure 8 (by contrast to corresponding Figure 2 and Figure 4), the knife 26 is not shown. This is to illustrate the essential point, that the upper clamping member 24, because it is cantilevered, is fully supported, and resists the load placed upon it, without any knife being present. Saltzmann and Buhayer are incapable of achieving the configuration shown in Figure 6 and Figure 8, so there is no anticipation.

Rejections Based on Bielagus

Claims 1, 3 - 5, 7, 15, 18, 19, 20, 21, 27, and 28 stand rejected under 35 U.S.C. §102(b) as being anticipated by Bielagus et al., U.S. Patent No. 5,937,923.

Claims 1, 3 - 5, 18, 19, 27

Applicant respectfully traverses the rejections with respect to claims 1, 3 - 5, 18, 19, and 27 for the reason provided in the Remarks to Applicant's Amendment filed February 2, 2007

(Page 11). These claims all depend from claim 1 and require a cantilevered upper clamping member, and Bielagus does not teach or suggest a cantilevered upper clamping member.

Claim 15

Claim 15 is cancelled.

Claims 7, 20

Applicant respectfully traverses the rejections with respect to claims 7 and 20 for the reason provided in the Remarks to the aforementioned Amendment at Pages 11 - 12. These claims require interlocking portions defining the claimed angle ϕ, and while the Office Action refers to a "marked copy fig. 6," no such copy was included with the Office Action.

Figure 6 of Bielagus does not appear to show a wearshoe that meets the claim requirements of both clamping the knife and being bolted to the base. Moreover, the claimed angle is defined relative to the axis of the bolt, so without any such bolt in Bielagus, Bielagus is fundamentally incapable of teaching the claimed angle.

In addition, with regard to the Examiner's note, that she "takes the position" that the angle is 50 degrees, Applicant respectfully submits that if Bielagus discloses a wearshoe and a bolt meeting the claim requirements, and if it further discloses interlocking portions thereof meeting at an angle, that angle can be measured, and it will either fall within the claimed range or not. Neither the Applicant nor the Examiner would be free to take a position different from the objective fact of the matter.

Claim 21

With respect to the rejection of claim 21, assuming the Examiner is referring to structures shown in Figures 5 or 6 of Bielagus, the component 42 slopes in the wrong direction to provide

the angle (defined in Figure 14) and functionality claimed, so Bielagus does not anticipate claim 21, and further teaches against claim 21.

Section 103 Rejections

Claims 10, 11, 17, and 22 - 26

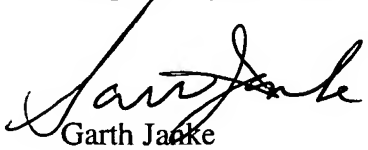
These claims stand rejected as being unpatentable over Loth, U.S. Patent No. 6,561,885 in view of Swartwood, U.S. Patent No. 5,979,522. The Examiner states that Loth teaches most of the elements of the claimed invention, except for a knife with dual cutting edges.

However, claim 17 depends from claim 9 which requires shoulder bolts, and neither Loth nor Swartwood discloses shoulder bolts. In particular, the bolts in Figure 3 in Loth are drawn as ordinary bolts, i.e., no shoulder portions are disclosed. Moreover, the Office Action contains no allegation, evidence or reasoning that it would have been obvious to provide shoulder bolts in the combination claimed.

Claims 27 and 28

The rejections of claims 27 and 28 as being unpatentable over Bielagus in view of Swartwood are moot in view of the comments made above with respect to the patentability of claims 1 and 20 in view of Bielagus.

Respectfully submitted,



Garth Janke
Reg. No. 40,662
(503) 224-2180

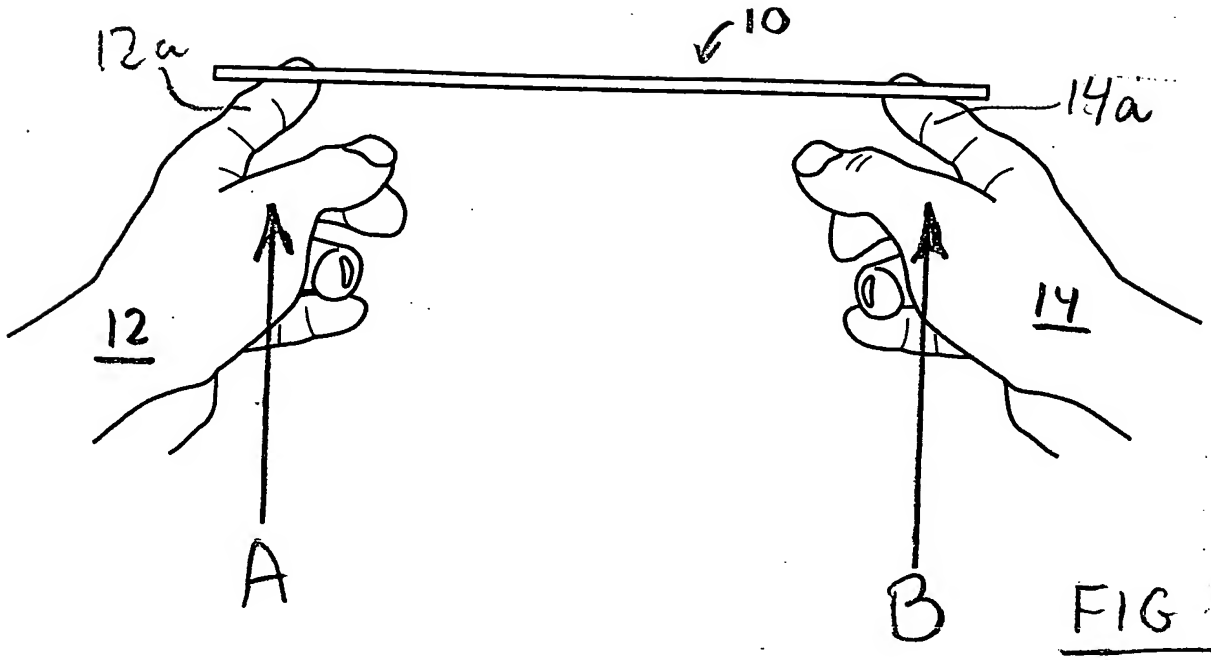


FIG 1

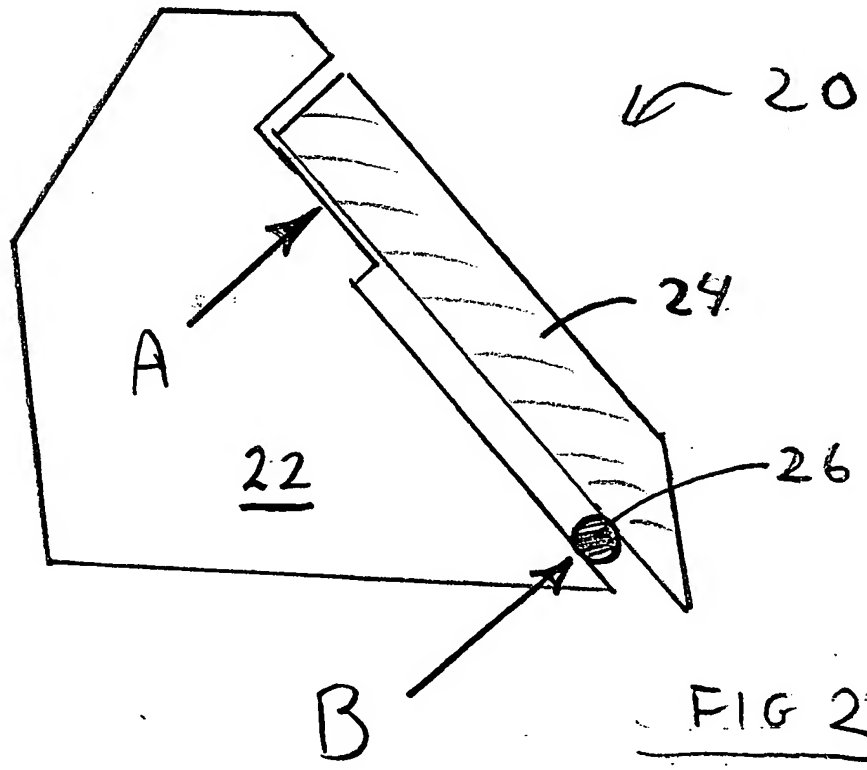


FIG 2

ATTACHMENT

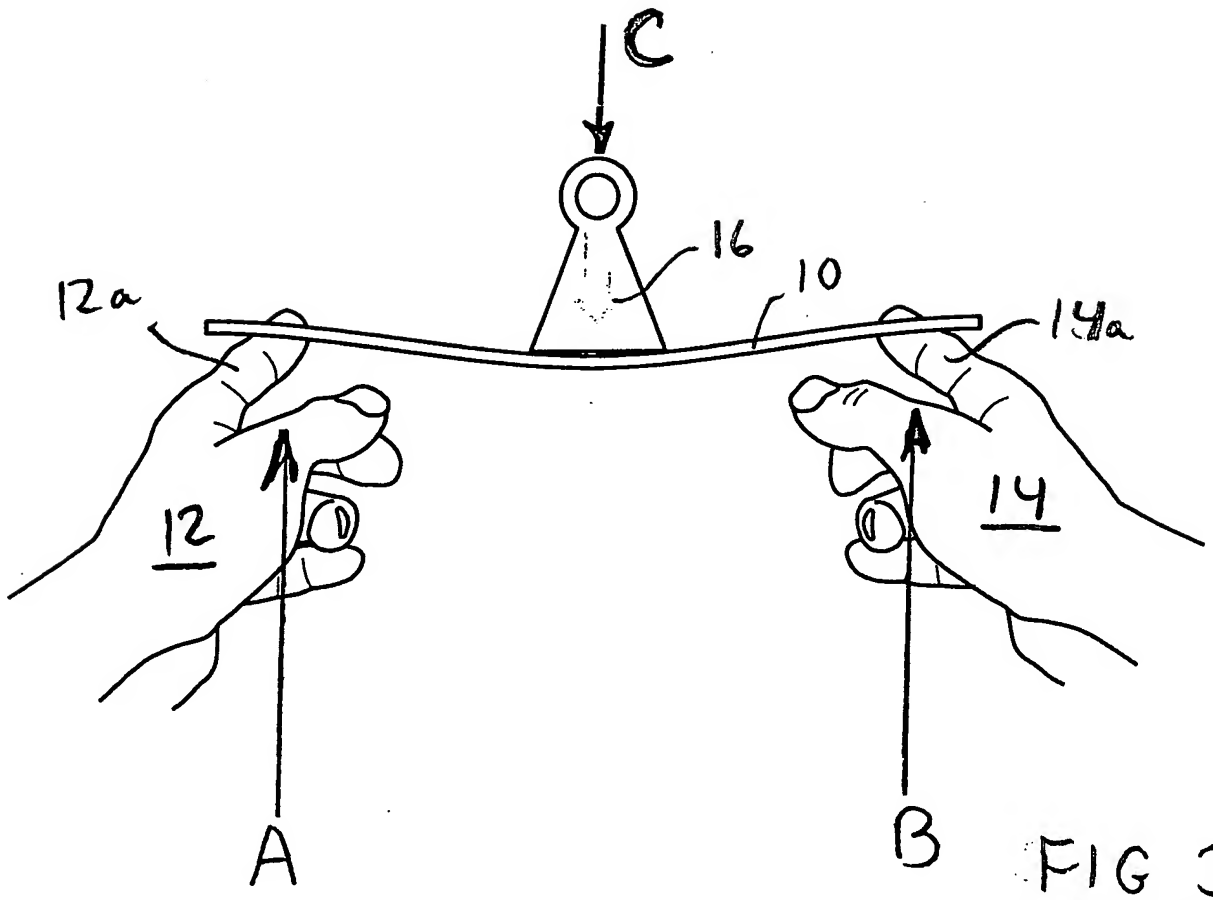


FIG 3

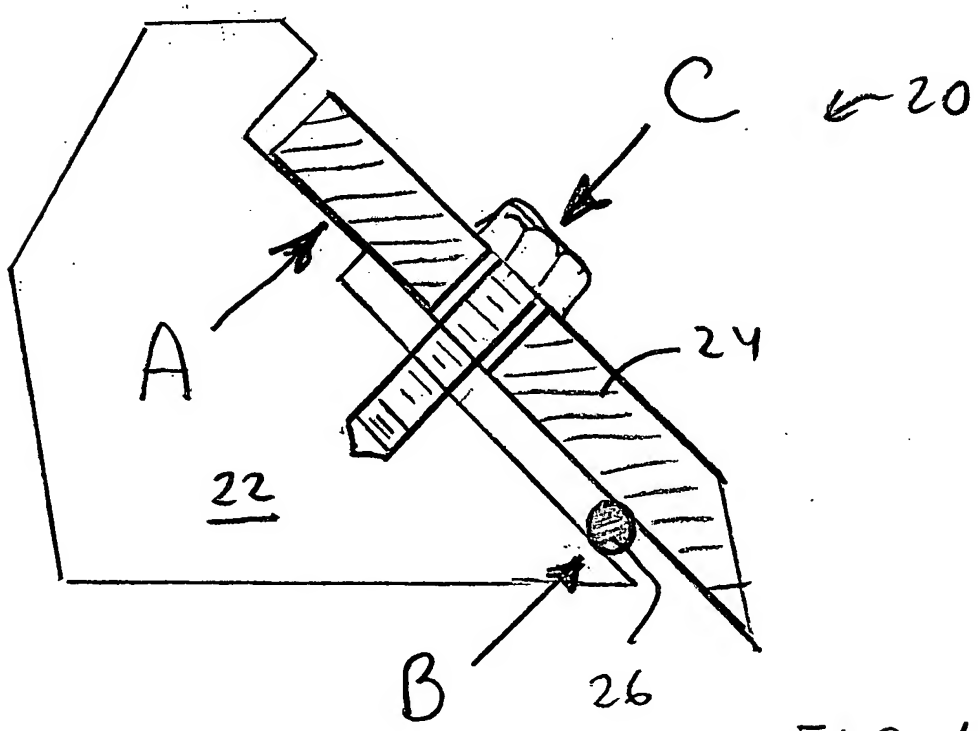


FIG 4

ATTACHMENT

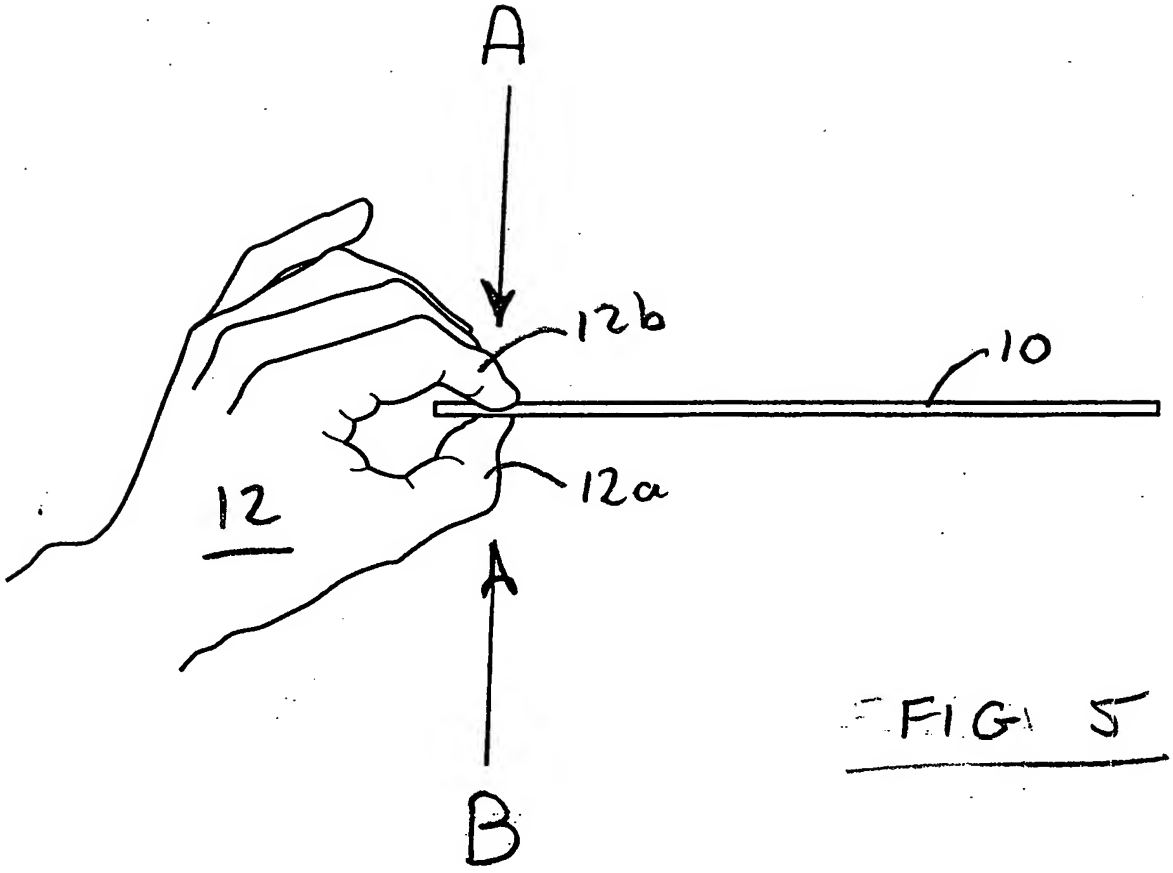


FIG 5

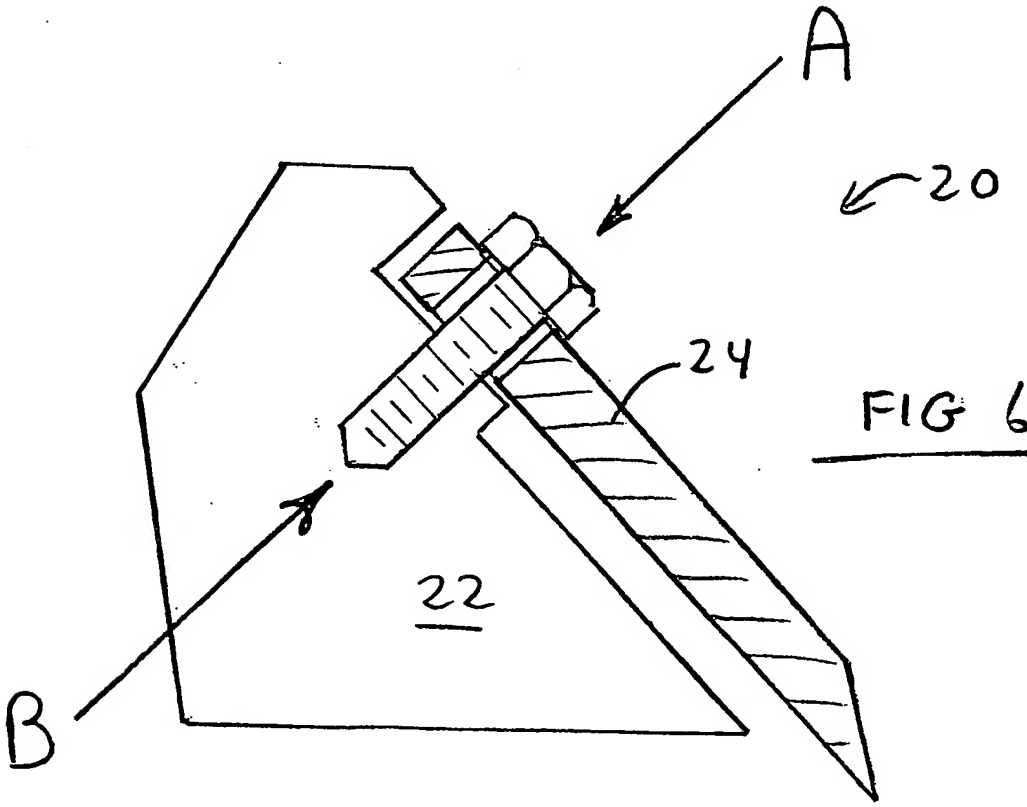


FIG 6

ATTACHMENT

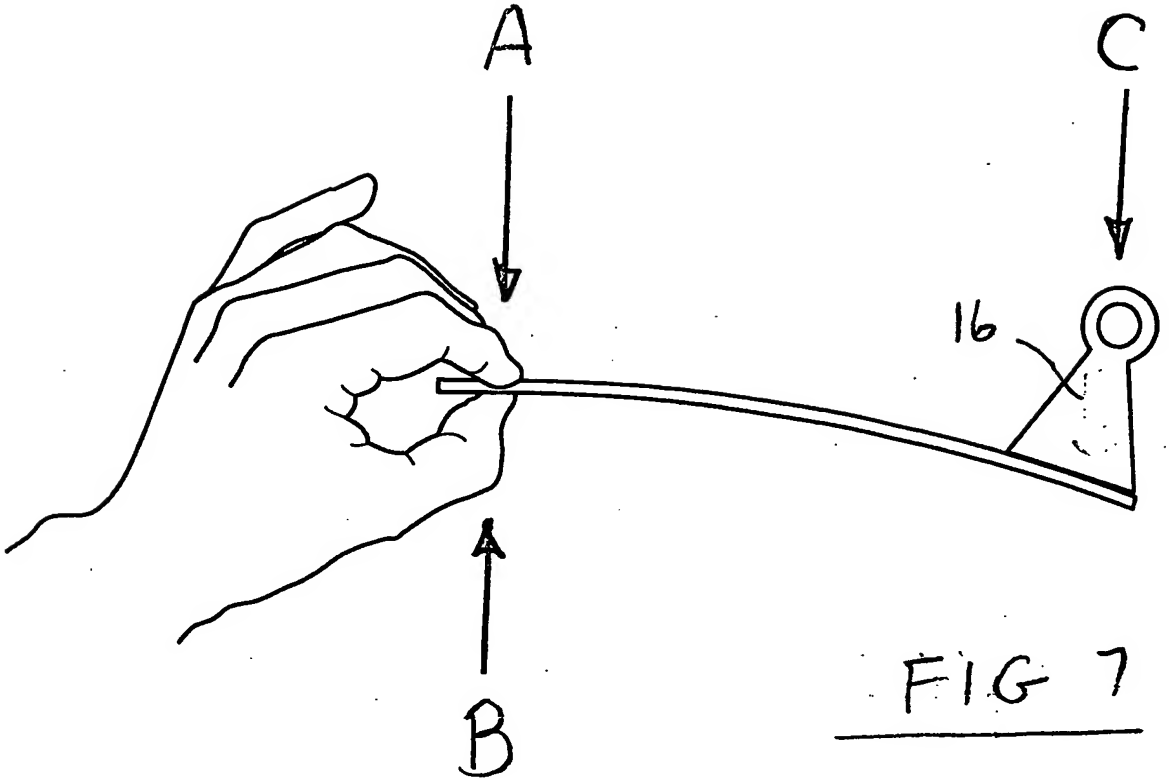


FIG 7

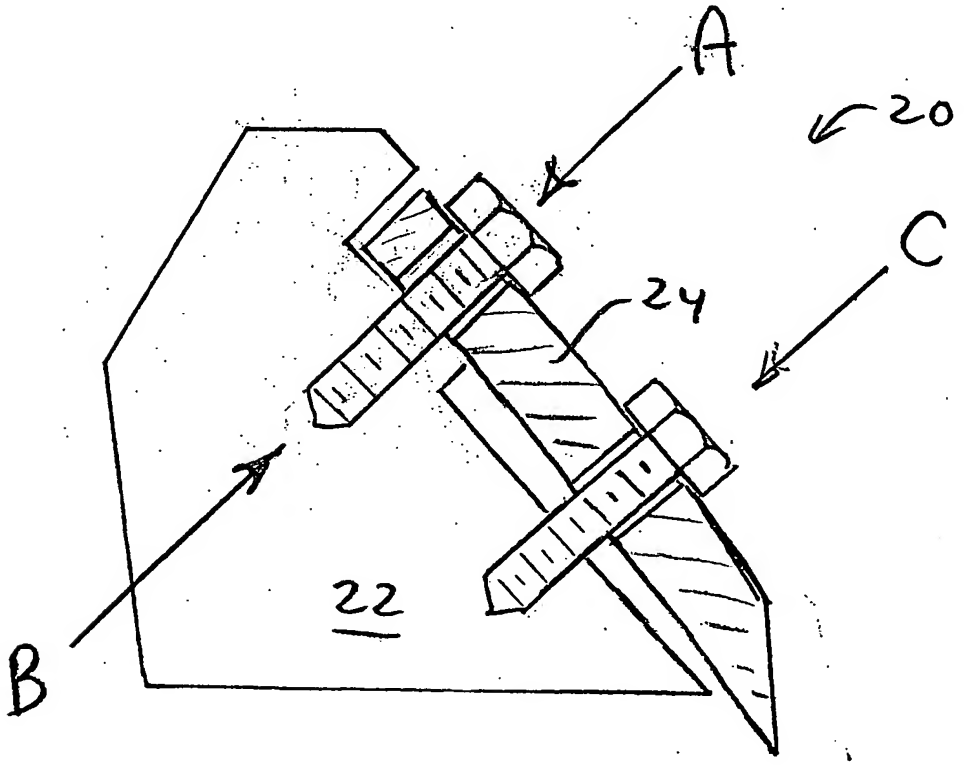


FIG 8

ATTACHMENT